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Docket No. 5000-5118

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Tomohei SUGIYAMA et al. Group Art Unit: 2891
Serial No : 10/626,418 Examiner: D. Menz
Filed : July 23, 2003
For : METHOD OF MANUFACTURING A LOW EXPANSION MATERIAL
AND SEMICONDUCTOR DEVICE USING THE LOW EXPANSION
MATERIAL

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the May 4, 2005 Office Action, the Examiner issued a restriction requirement, requiring Applicants to elect one of four groups of claims:

- I. "Claim 1-8, drawn to a method of manufacturing a low expansion material, classified in class 75, subclass 330";
- II. "Claims 9-10, drawn to a semiconductor device, classified in class 257, subclass 741";
- III. "Claims 11-12, drawn to a semiconductor device with a semiconductor element mounted directly to a heat sink, classified in class 257, subclass 707"; or
- IV. "Claims 13-14, drawn to a semiconductor device with a heat releasing plate, classified in class 257, subclass 712."

Applicants provisionally elect Group III, claims 11-12.

Applicants furthermore respectfully traverse the Examiner's restriction requirement.

As the Examiner recognizes, Group III can be given the following class/subclass classification: 257/707. Applicants maintain that Group III can also be given the additional class/subclass classifications: 257/741 or 257/712.

As the Examiner further recognizes, Group IV can be given the following class/subclass classification: 257/712. Applicants maintain that Group IV can also be given the additional class/subclass classification: 257/741. This is the same class/subclass classification the Examiner recognizes can be ascribed to Group II.

Applicants respectfully submit that for a restriction requirement to be proper, MPEP §803, is clear that "there are two criteria for restriction between patentably distinct inventions" as follows:

- “(1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required” (emphasis added)

Applicants maintain that they should be permitted to prosecute Groups II-IV together because searching the species of Group II (257/741), Group III (257/707, 257/712 and 257/741) and Group IV (257/712 and 257/741) would not require any undue diverse searching or place any serious burden on the Examiner if restriction were not required between these three groups, as they can all be classified in class/subclass 257/741.

Alternatively, should the Examiner disagree that the species of Groups II – IV can be classified in the same class/subclass, Applicants maintain that they should be permitted to prosecute Groups III and IV together because searching the species of Group III (257/707, 257/712 and 257/741) and Group IV (257/712 and 257/741) would not require any undue diverse searching or place any serious burden on the Examiner if restriction were not required between these two groups, as they can both be classified in class/subclass 257/712.

Therefore, Applicants respectfully request that the Examiner withdraw his restriction requirement.

The Commissioner is hereby authorized to charge any additional fees which may be required for this response, or to credit any overpayment to Deposit Account No. 13-4500, Order No. 5000-5118. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 5000-5118. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: June 6, 2005

By: _____


Peter N. Fill

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CERTIFICATE OF MAILING (37 C.F.R. §1.8(A))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached:

1. Response to Requirement for Restriction;
2. Return Receipt Postcard;

along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on date shown below with sufficient postage as first-class mail in an envelope addressed to the: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: June 6, 2005

By: 

Peter N. Fill
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